

10/752,898

BBUCP101USA

Remarks

Claims 1-2, 5-10, 13, 15, 16, 19, 21-23, and 25-27 are currently pending in the subject application and are presently under consideration. A new listing of the claims is at pages 2-5 of the Reply. Claims 1, 6, 10, 13, 19, 21, 26, and 27 have been amended to more clearly recite the invention. Claims 3, 4, 11, 12, 14, 17, 18, 20, and 24 have been canceled.

Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

I. Rejection of Claims 1-2, 5-13, 15-19, 21-23, and 25-27 under 35 U.S.C. §112, first paragraph

Claims 1-2, 5-13, 15-19, 21-23, and 25-27 had been rejected under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the written description requirement, by claiming subject matter not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claims had been amended in part to overcome similar grounds cited in the previous Office Action. The claims are again rejected on these grounds in the outstanding Office Action, stating that "the application does not appear to disclose the subject matter of claims 1, 10-13, 15-19, 21-23, and 27, as applicant did not mention where in the specification support is found for the amendments." These grounds of rejection are traversed for at least the following reasons.

The Office Action does not indicate which subject matter is deemed to not be disclosed in the application. Thus, no guideline is offered for understanding the basis for the rejection and preparing a specific response thereto. Further, the Office Action does not cite any authority for the requirement that specific portions of an application be cited in support of an amendment, nor why such a requirement would constitute a rejection under 35 U.S.C. § 112, first paragraph. It is respectfully requested that either such citations be provided or else that this grounds of rejection be withdrawn.

In any event, it is respectfully submitted that the claims as presently presented are believed to comply with 35 U.S.C. § 112, first paragraph. Thus, reconsideration and withdrawal of the rejection is respectfully requested.

10/752,898

BBUCP101USA

II. Rejection of Claims 1-2, 5-13, 15-19, 21-23, and 25-27 under 35 U.S.C. §112, second paragraph

Claims 1-2, 5-13, 15-19, 21-23, and 25-27 are rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which the application regards as the invention.

It is respectfully submitted that this rejection should be withdrawn for at least the following reason. The claims have been amended to more clearly emphasize the invention.

Claim 1 has been amended to remove the objectionable terms "physically differentiated" and "prolonged motion."

Claims 1 and 10 have been amended to change the objectionable term "consumable" to "edible."

Claim 10 has been amended to clarify the objectionable terms "outer edible material" and "different edible components," and to remove the expression "extended period of time."

The amendments to claim 10 are believed to overcome the grounds for rejection of claims 15 and 16.

The rejections of claims 17 and 18 are obviated by the cancellation of these claims.

Claims 21 and 27 are rejected for the term "homogeneous mixture," which as is asserted in the Office Action, "appears to conflict with itself, since it is unclear how a 'homogeneous mixture' can have different components." It should be noted that Webster's Third New International Dictionary (unabridged) includes numerous definitions of the term "homogeneous," including "of uniform structure or composition throughout <~ granite>...." From the indicated example, it is clear that "homogenous" is not limited single components as suggested in the Office Action, since it is well known that granite contains a uniform distribution of quartz and feldspar crystals. Notwithstanding, the PTO is reminded that applicant is entitled to be his own lexicographer (MPEP 2173.05(a)), and since the term "homogeneous" is not used herein in a manner contrary to its ordinary meaning as indicated above, it is respectfully submitted that the usage herein is sufficiently clear to enable one having skill in the art to practice the invention, and thus this term is not in fact objectionable as stated in the Office Action.

Claim 27 has been amended to overcome the antecedent objection thereto.

10/752,898

BBUCP101USA

In view of the foregoing discussion, it is requested that the rejection be withdrawn for independent claims 1, 10 and 21, and the claims that depend therefrom.

III. Rejection of Claims 1, 2, 5, 8, 11-13, and 17-19 under 35 U.S.C. §103(a)

Claim 8 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Brekau (DE 29703253) in view of Smith (US Patent No. 1,022,113).

Applicant's representative respectfully requests that Examiner withdraw the rejection for at least the following reasons. Neither Brekau nor Smith, alone or in combination, teach or suggest applicant's invention as recited in the subject claims.

To reject claims in an application under §103, an examiner must establish a *prima facie* case of obviousness. A *prima facie* case of obviousness is established by a showing of three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) *must teach or suggest all the claim limitations*. See MPEP §706.02(j). The *teaching or suggestion to make the claimed combination* and the reasonable expectation of success *must be found in the prior art and not based on the Applicant's disclosure*. See *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added).

An examiner cannot establish obviousness by locating references which describe various aspects of a patent applicant's invention without also providing evidence of the motivating force which would impel one skilled in the art to do what the patent applicant has done. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993).

Brekau is again cited for allegedly disclosing an edible toy for an animal having a shell and an edible material therein surrounded by the shell. As is clear from the passages of this reference cited in the Office Action (page 2, lines 5-20), Brekau discloses a cat toy having two half-shells into which food is inserted. It is evident from Fig. 2 of Brekau that a small ball of food is inserted into the larger half-shells, so that the food will roll around inside the half-shells upon enclosure. Therefore, Brekau does not disclose or suggest *underlying layers* as recited in the subject independent claim 1, nor does this reference disclose or

10/752,898

BBUCP101USA

suggest an inner edible material that is *encased*, as recited in independent claims 1, 10, and 19. Further, there is no description of the food whatsoever in the four corners of Brekau, other than to say that it “is in solid form.” (See, e.g., page 2, line 6.) The contention made in the Office Action that Brekau discloses on page 2, line 15+ that the inner edible material can be “a liquid, paste, or one or more edible objects” is incorrect since no such disclosure is actually found in the Brekau reference. Therefore, nothing can be inferred or understood as to the nature of the solid food mentioned in the reference. For at least that reason, this reference cannot be relied upon to disclose or suggest an *underlying layer formed of an edible material* such that the *underlying layer comprises a layer binding material that provides consistency to retain form and the binding material releases layer materials upon penetration*, as is generally recited in the independent claims.

The Office Action admits that Brekau does not disclose an inner and outer material that includes *catnip*. For this reason, a combination is proposed with Smith in order to shore up this admitted deficiency. However, Smith simply discloses a ball of catnip, either a solid ball as shown in Figs. 1 and 2, or at least a portion formed around a solid core (i.e., wood or rubber) as shown in Figs. 3 and 4. Smith merely discloses catnip, not an *edible material including catnip* as recited in the subject claims. Smith uses an inert binder of wood or paper pulp to retain the catnip in a solid mass. (See, e.g., page 1, lines 49-64.) Therefore, Smith cannot be relied upon to show an *underlying layer of an edible material* comprising a *binding material that provides consistency to retain form, the binding material releases layer materials upon penetration*, as presently claimed.

In view of the foregoing discussion, it is not clear how Smith’s solid ball of catnip is to be combined with the hollow half-shelled structure containing a small ball of food as disclosed in Brekau. While both of these references are from the field of cat toys, they are very different from each other in structure and function. No clear manner is suggested by the references whereby these devices may be combined. It is therefore respectfully submitted that one having skill in the art would not arrive at the claimed subject matter from these references unless also guided by a hindsight reading of the subject disclosure. Hence, there is no motivation to combine the references, and it would not have been obvious to one skilled in the art to do so. For at least the aforementioned reasons, it is respectfully submitted that

10/752,898

BBUCP101USA

the Brekau and Smith references, taken alone or in combination, do not disclose or suggest each and every aspect of the claimed subject matter.

Attention is now drawn to the attached Declaration Under 37 CFR 1.132 which presents evidence of the commercial success found by applicant and the long-felt need for the claimed subject matter in the marketplace. It is respectfully requested that due consideration be given to this evidence, particularly in view of the weakness of the proposed combination as demonstrated above.

In view of the aforementioned discussion, it is respectfully submitted that Brekau and Smith, taken alone or in combination, fail to disclose or suggest every aspect of the claims, and further, the combination is unmotivated, as are requirements for a prima facie demonstration of obviousness. Accordingly, for least these reasons, it is respectfully requested that this rejection be withdrawn, and that independent claims 1, 10, and 19 be allowed, along with claims 2, 5-9, 13, 15, and 16 that depend respectively therefrom.

IV. Rejection of Claims 6, 7, and 9 under 35 U.S.C. §103(a)

Claims 6, 7, and 9 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Brekau in view of Smith, and further in view of Fisher (U.S. Pat. No. 4,260,635).

Applicant's representative respectfully requests that this rejection be withdrawn for at least the following reasons. As shown hereinabove, neither Brekau nor Smith, alone or in combination, disclose or suggest the subject matter of the independent claims. Fisher fails to disclose or suggest anything additional that would overcome the deficiencies of the Brekau and Smith. Therefore, claims 6, 7, and 9 are allowable for at least the same reasons as the independent claims and this rejection should be withdrawn.

V. Rejection of Claims 15 and 16 under 35 U.S.C. §103(a)

Claims 15 and 16 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Brekau in view of Smith, and further in view of Lindgren (U.S. Pat. No. 5,965,182).

Applicant's representative respectfully requests that this rejection be withdrawn for at least the following reasons. As shown hereinabove, Brekau and Smith, taken alone or in combination, do not disclose or suggest the subject matter of the independent claims. Lindgren fails to supply any additional disclosure or suggestion that would supply the

10/752,898

BBUCP101USA

deficiencies of the Brekau and Smith. Thus, claims 15 and 16 are allowable for at least the same reasons as the independent claims. Accordingly, this rejection should be withdrawn.

VI. Rejection of Claims 21-23, 25 and 27 under 35 U.S.C. §103(a)

Claims 21-23, 25, and 27 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Brekau in view of Kealy (U.S. Pat. No. 3,930,031).

As noted hereinabove, nothing is disclosed or suggested in the Brekau reference as to the nature of the food used therein, other than that it is solid. Therefore, this reference cannot be relied upon to disclose or suggest a method including *providing a binding material that provides consistency to retain form and mixing the edible material and binding material into a homogeneous mixture*, as recited in independent claim 21. Kealy is merely cited for teaching a cat food composition having a "marbling effect," which is construed as "homogenous" in the Office Action. However, it is plain that Kealy does not disclose a binding material as claimed. Therefore, even if motivation could be found for combining these references as proposed in the Office Action, the combination would nevertheless fail to disclose or suggest every aspect of the claimed subject matter.

In view of the aforementioned discussion, it is respectfully submitted that Brekau and Kealy, taken alone or in combination, fail to disclose or suggest every aspect of the claims, as is required for a prima facie demonstration of obviousness. Accordingly, for least these reasons, it is respectfully requested that this rejection be withdrawn, and that independent claims 21 be allowed, along with claims 22, 23, 25, and 27 that depend respectively therefrom.

VII. Rejection of Claims 26 under 35 U.S.C. §103(a)

Claim 26 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Brekau in view of Kealy, and further in view of Lindgren.

Applicant's representative respectfully requests that this rejection be withdrawn for at least the following reasons. As shown hereinabove, neither the Brekau nor Kealy references, taken alone or in combination, disclose or suggest the subject matter of the independent claims. Lindgren does not provide anything additional that would shore up the deficiencies of the Brekau and Smith. Thus, claim 26 is allowable for at least the same reasons as the

10/752,898

BBUCP101USA

independent claim from which it depends. Accordingly, this rejection should also be withdrawn.

10/752,898

BBUCP101USA

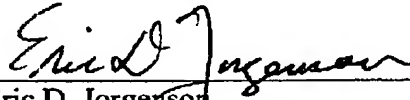
CONCLUSION

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact Applicant's undersigned representative at the telephone number below.

In the event any additional fees may be due, the Commissioner is authorized to charge such fees to Deposit Account No. 50-3663 [BBUCP101USA]

Respectfully submitted,


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